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Atty. Dkt. No. 035451-0120 (3600.Palm)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hanson et al.

Title: EXPANDABLE
MINIATURE
ACCESSORY CARD FOR
HANDHELD COMPUTER

Appl. No.: 09/821,522

Filing Date: 3/29/2001

Examiner: Trisha U. Vu

Art Unit: 2112

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

EV 459171258 US 01/21/05
(Express Mail Label Number) (Date of Deposit)

RobertasA. Cooper

(Printed Name)

Roberta A. Cooper
(Signature)

DECLARATION UNDER 37 C.F.R. § 1.131

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

We, Yoon Kean Wong and William R. Hanson, state and declare that:

1. Each of us conceived the subject matter recited in at least one of Claims 1-69 currently pending in U.S. Patent Application No. 09/821,522 titled "Expandable Miniature Accessory Card for Handheld Computer" (hereinafter referred to as "the '522 application").
2. We understand that in an Office Action dated November 02, 2004, Claims 1-69 were rejected as being unpatentable.
3. We understand that the rejection of Claims 47-69 was based in part on the use of U.S. Patent Application Publication No. 2001/0042149 to Ito et al., entitled "Peripheral Device for Information Processing" (hereinafter "Ito et al.").
4. We understand based on the information provided on the front page of Ito et al. that Ito et al. has a filing date of December 28, 2000.

5. At least by December 11, 2000, we conceived the ideas set forth in Claims 1-69 of the '522 application. Such conception is evidenced by the following attached document:
 - a) A copy of an Invention Disclosure Form that indicates a conception date of December 11, 2000 in Section 3, on page 2, in Santa Clara, CA (Attached as Exhibit A).
6. Based on the document provided herewith and our best recollection, the conception of the ideas set forth in Claims 1-69 of the '522 application took place at least by December 11, 2000, which is before the December 28, 2000 filing date of Ito et al.
7. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent application or any patent issuing therefrom.

Date: 1/14/05

By: Kean Wong
Yoon Kean Wong

Date: _____

By: _____
William R. Hanson



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Date: _____

By: _____

Yoon Kean Wong

Date: 11/22/05

By: 

William R. Hanson

Palm, Inc. Invention Disclosure Form
5470 Great America Parkway, Santa Clara, CA. 95052.**Instructions:**

- Any questions regarding this form should be referred to Henry Ohab at (408) 326-5501, Fax: (408) 326-5009, or E-mail Henry_Ohab@Palm.com
- Return Completed Form To: Henry Ohab

Date Stamp:**1. Title of the Invention:** Write a short descriptive title, avoiding coined terms and product names.**Expandable Accessory (SDIO) Card for a Handheld Computer****2. Inventors:** Include the names of all persons who made a contribution to the conception of the invention. If there are more than five inventors, list at end of this form.

Full Name:	William Robert Hanson	M.S.	16124
Home Address:	605 Pettis Ave., Mountain View, CA 94041		
Home Phone:	650.962.1817	Work Phone:	408.326.0196
Employee No.	25202		
Supervisor:	Frank Canova	Location:	Bldg. 16 (Santa Clara)
Citizenship:	USA		
Full Name:	Yoon Kean Wong	M.S.	10302
Home Address:	200 Linfield Drive, #1 Menlo Park, CA 94025		
Home Phone:	650.321.6382	Work Phone:	408.326.9901
Employee No.	23210		
Supervisor:	Ken Comstock	Location:	Bldg. 10 (Santa Clara)
Citizenship:	New Zealand		
Full Name:		M.S.	
Home Address:			
Home Phone:		Work Phone:	
Employee No.			
Supervisor:		Location:	
Citizenship:			
Full Name:		M.S.	
Home Address:			
Home Phone:		Work Phone:	
Employee No.			
Supervisor:		Location:	
Citizenship:			

This Invention Disclosure Form is submitted pursuant to your employment agreement with Palm, Inc. In accordance with said agreement, you have agreed to assign and hereby do assign all rights, title, and interest in the above described invention and any patent applications and patents based on this invention to Palm, Inc. and its subsidiaries.

3. Conception of the Invention

Date of conception: December 11, 2000 Location of conception Palm Source 2000

4. Related Art

Is this invention an improvement of an existing COMPANY product? No Yes

If "Yes," identify the existing product: N/A

and identify the improvement

- What was the problem to be solved? **A means to add additional media or memory to SD card equiped handheld device once the slot has been occupied by a SDIO module . This is accomplished through the addition of a second SD or MMC slot connector.**

How had others attempted to solve it before you?

Yes, San Disk and Socket Communications have proposed a two part SDIO card. One portion is the I/O function and the second portion being the media or memory. This does not provide an additional socket.

What were the problems or disadvantages with prior solutions?

Mechanically the San Disk / Socket device is inferior. It also does not provide a means of adding media or memory using standard SD or Multimedia cards.

What are the closest known prior art technology or products?

Innogear (<http://www.innogear.com/>) has a Handspring Springboard Module MP3 player that accepts Multimedia card media.

5. Reference Materials

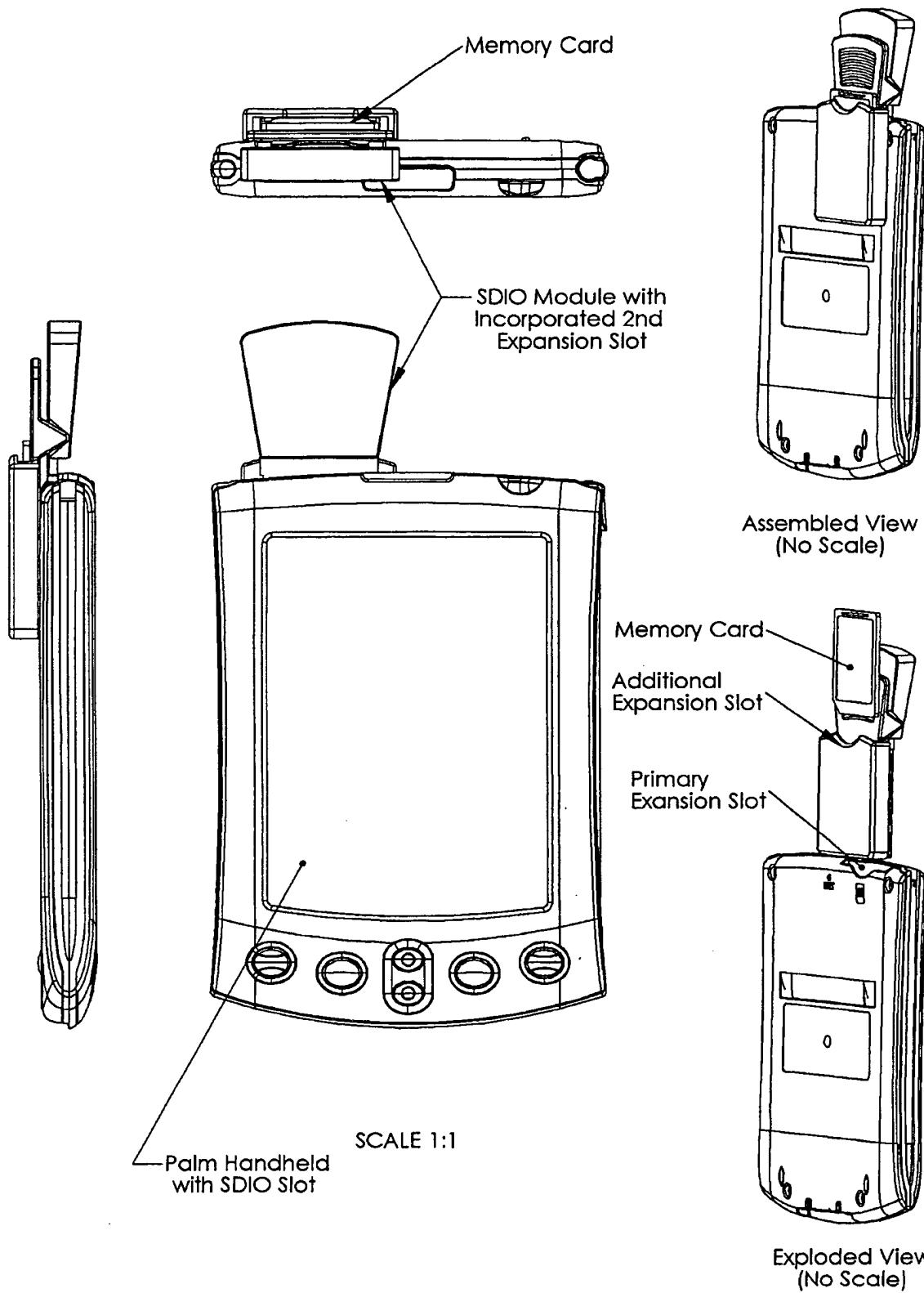
List any printed publications, patents, patent applications or any other materials you are aware of which provides background material and/or prior art for your invention.

Innogear (<http://www.innogear.com/>)

What other companies or inventors might have prior art?

6. Drawings of the Invention

Please submit clear drawings which illustrate the invention either by electronically inserting them below or by using supplemental sheets if you cannot electronically insert them.



7. Brief Description of the Invention

Describe the structure, function and/or method of the invention in just enough detail to enable someone technical to understand how you solved the problem. Explain how the invention solves the problem identified in Section 4 above.

SDIO modules such as MP3 players, GPS receivers, and digital cameras require the transfer of digital media. (i.e. MP3 formatted songs etc.) Having this memory available on the SDIO device increases the cost of the module as well as requires a means to download alternative content. Only a finite amount of content is available on SDIO module. Having removable media allows the user to pick and choose the content quite easily. The proposed invention expands on the "traditional" SDIO module by providing a structure with the addition of a second SD or MMC connector.

8. Strategic/Tactical Value of the Invention

Very briefly, explain how this invention will have strategic value to the company. That is, how could such a patent help Palm, Inc. and/or how could such a patent adversely affect our competitors, both in the present and in the future?

Since Palm does not intend to develop SDIO modules at this time, the primary purpose of this patent is to protect our 3rd party developers from being prevented from using this format. However, this does provide a solution to the single SD slot problem that exists on competitive handheld devices as well as ours. This may provide Palm a strategic advantage and further evangelize the use of Secure Digital Media.

9. Joint Development or Development Contract

Was this invention jointly developed with inventors from another company? No Yes

If "Yes," please identify the company and/or non-Palm inventors: _____

10. Release

Expected/actual date of first public release or showing of invention or product incorporating or using the invention.	No date set.
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11. Publication of the Invention

Publication of a description of the invention may affect COMPANY's right to patent the invention. Submit this form even if publication has occurred.

Has a description been published or is it scheduled to be published? No Yes

If "Yes," when and to whom? _____

12. Attorney

If there is a particular patent attorney with whom you would like to work on this disclosure, suggest his/her name. None.

This is a SUPPLEMENTAL INVENTOR SHEET which is to be used if there are more than 4 inventors for the invention set out in the Invention Docket specified above.

13. Additional Inventors Include names of all persons who made a contribution to the conception of the invention. If there are more than five inventors, use a Supplemental Sheet.

Full Name:	M.S.
Home Address:	
Home Phone:	Work Phone:
Employee No.	
Supervisor:	Location:
Citizenship:	:
Full Name:	M.S.
Home Address:	
Home Phone:	Work Phone:
Employee No.	
Supervisor:	Location:
Citizenship:	:
Full Name:	M.S.
Home Address:	
Home Phone:	Work Phone:
Employee No.	
Supervisor:	Location:
Citizenship:	:
Full Name:	M.S.
Home Address:	
Home Phone:	Work Phone:
Employee No.	
Supervisor:	Location:
Citizenship:	:
Full Name:	M.S.
Home Address:	
Home Phone:	Work Phone:
Employee No.	
Supervisor:	Location:
Citizenship:	:

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